

REMARKS

By the present amendment, Applicants have amended claims 1, 14, 25, 29, and 31-33 and canceled claims 9, 20, 26, 27, and 30 without prejudice or disclaimer. Support for these amendments may be found in the original claims and the specification at page 10, paragraph 0032, for example. No new matter has been added. Upon entry of these amendments, claims 1-8, 10-19, 21-25, 28, 29, and 31-35 will remain pending in this application.

In the Office Action¹, the Examiner rejected claims 1-3, 6-8, 10, 12-19, 21-26, 28, and 29 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,130,885 to Chandra et al. ("*Chandra*"); and rejected claims 4, 5, 9, 11, 20, 27, 28, and 30-35 under 35 U.S.C. § 103(a) as being unpatentable over *Chandra* in view of U.S. Patent No. 5,884,035 to Butman et al. ("*Butman*").

I. Rejection of Claims 1-3, 6-8, 10, 12-19, 21-26, 28, and 29 under 35 U.S.C. §102(e) as being anticipated by *Chandra*

Applicant respectfully traverses the rejection of claims 1-3, 6-8, 10, 12-19, 21-26, 28, and 29 under 35 U.S.C. § 102(e) as anticipated by *Chandra*. In order to properly establish that *Chandra* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim."

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claims 1 recites a method including, for example:

wherein the selected message type is selected at the user interface and the message is automatically filtered according to the selected message type.

Chandra fails to teach at least these elements.

Chandra appears to relate to transportable applications that enable users to share documents. The Examiner correctly states that *Chandra* does not teach “filtering the message in the channel based on the message type.” See Office Action at page 13. *Chandra* discloses, “[t]he user may filter the list of transportable applications by application type using a drop-down menu.” See col. 38, lines 62-64. However, any filtering in the *Chandra* system occurs through user interaction with a drop-down menu. In contrast, claim 1 requires automatic filtering of a message “according to the selected message type.” Automatic filtering according to the selected message type is not taught or suggested in *Chandra*. Moreover, *Chandra* does not disclose selecting the message type at the user interface. Therefore, *Chandra* does not teach or suggest the claimed “wherein the selected message type is selected at the user interface and the message is automatically filtered according to the selected message type,” as recited in claim 1.

For at least the above reasons, *Chandra* does not anticipate independent claim 1. Claims 2, 3, 6-8, 10, 12, and 13 depend from claim 1 and are, thus, also allowable over *Chandra* for at least the same reasons indicated above for claim 1. Independent claims 14, 25, and 29, while of a different scope, recite elements similar to those of claim 1 and are, thus, also allowable over *Chandra* for reasons similar to that

discussed above for claim 1. Claims 15-19, 21-24, and 28 are also allowable at least due to their dependence from independent claim 14 or 25. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e) is therefore respectfully requested and deemed appropriate.

Furthermore, Applicant notes that, in the rejection of dependent claim 9, the Examiner asserts, “the general concept of filtering based on message type is well known in the art as illustrated by Butman et al.” See Office Action at page 13. Applicant respectfully disagrees.

The Examiner cites col. 22, lines 6-21 to allegedly disclose the claimed filtering according to the message type. This passage discloses a domain client objects table 62. This table includes “an ASCII text format report 62a, a slide presentation 62b, a word processing document 62c . . .” ASCII text format report 62a is handled as ASCII text and all other documents are handled as files.

The Examiner appears to assert that handling different documents as text or files reads on the claimed “automatically filtered according to the selected message type.” This is not correct. In *Butman*, the documents are handled as text or files. However, there is no teaching in *Butman* that the documents are filtered according to a “message type.” *Butman* only discloses transmitting the document in its particular format, such as text or a file. Transmitting a document as text or a file does not teach or suggest filtering the document according to a “message type.”

Moreover, *Butman* does not disclose selecting a message type at a user interface because no user interface for selecting a message type exists in *Butman*. Therefore, *Butman* does not teach or suggest at least “wherein the selected message

type is selected at the user interface and the message is automatically filtered according to the selected message type,” as recited in claim 1.

II. Rejection of Claims 4, 5, 9, 11, 20, 27, 28, and 30-35 under 35 U.S.C. § 103(a) as being unpatentable over *Chandra* in view of *Butman*

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 4, 5, 9, 11, 20, 27, 28, and 30-35 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, *Chandra* and *Butman*, taken alone or in any proper combination, fail to teach or suggest each and every element of Applicant’s claim.

As previously discussed, *Chandra* and *Butman* do not teach or suggest at least “wherein the selected message type is selected at the user interface and the message is automatically filtered according to the selected message type,” as recited by independent claim 1, and similarly recited in independent claims 14, 25, and 29, and thus, required by dependent claims 4, 5, 11, 28, and 31-35.

Because neither *Chandra* nor *Butman*, taken alone or in combination, teach or suggest each and every element recited by independent claims 1, 14, 25, and 29, no *prima facie* case of obviousness has been established with respect to claims 4, 5, 11, 28, and 31-35 at least due to their dependence. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 4, 5, 11, 28, and 31-35 under 35 U.S.C. § 103(a) as being unpatentable over *Chandra* and *Butman*.

CONCLUSION

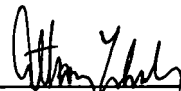
In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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